

### **REMARKS**

The Final Office Action mailed January 14, 2010 and the references cited therein have been carefully considered. The below remarks are submitted, in accordance with the Examiner's request during the recent telephone interview conducted on March 16, 2010. Claims 1-3 and 5-21 are currently pending in the application and Claim 11 is objected to as containing allowable subject matter but is a dependent claim. Claim 10 has been amended to delete the terms, "in particular" in the preamble. No other claim amendments are presented by this response in order to preserve Applicants' right to Appeal the rejections to the claims. Thus, Applicants reserve the right to file an appeal with respect to any claims determined not to be allowable.

Applicants have refrained from once again presenting arguments with regard to the patentability of independent Claims 1 and 21, as well as additional dependent claims. Applicants hereby incorporate by reference its arguments previously presented in this application, and particularly those presented on Appeal. This Response presents further arguments with regard to the patentability of dependent Claim 10, in view of Continued Prosecution by the Examiner and as discussed in the telephone interview of March 16, 2010 (further addressed below).

Accordingly, Applicant respectfully requests reconsideration of the rejections to claims 1-3 and 5-21, and particularly Claim 10 in view of the arguments incorporated herein by reference and those presented below.

### **Interview Summary**

Applicants would like to thank Examiner Pradeep Choudary Battula and Supervisory Patent Examiner Dana Roth for the courtesies extended their council during the telephone interview on March 16, 2010. Prior to the interview, an Outline was transmitted via facsimile to the Examiner, which proposed incorporating the limitations of dependent Claim 10 into both independent Claims 1 and 21. Also, the Outline presented substantially the same arguments included below with regard to the patentability of the aspect of Applicants' invention defined in Claim 10. During the interview, the pending claim rejections with regard to the subject matter of Claim 10 were discussed and particularly the patentability of Claim 10 with respect to the obviousness rejection based upon the combination of Weber and Garrard. No formal agreement was reached with regard to the claims and Examiner Battula indicated he would like to further consider Applicants remarks in writing. Accordingly, the below remarks set forth the analysis of the prior art and the patentability of Claim 10 as discussed during the Interview.

### **Claim Rejections under 35 USC § 103**

Claims 1-3, 6-10 and 12-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,808,792 to **Weber** in view of British Published Patent Application 2,326,375 to **Garrard**. The Office Action states that it would have been obvious to "use the pages and binding or fixing of Garrard with the passport of Weber for the purpose of securing various amounts of information together in the passport." Applicants respectfully traverse this rejection for the same reasons set forth in its Appeal Brief.

Applicants hereby take this opportunity to further discuss the patentability of pending Claim 10. Claim 10 defines that “at least the base film is provided with a perforation for cutting out the base film or the base film with the carrier film permanently connected thereto.” Applicants contend that even if one of ordinary skill were somehow to combine the teachings in Weber and Garrard, the invention defined in Claim 10 would not be rendered obvious.

Weber discloses a transfer foil for applying a decorative layer arrangement to safeguard security documents such as bank notes, identity documents or credit cards. The transfer foil disclosed by Weber includes label-like individual elements 17 that are intended to be applied to a target substrate 8 such as a security document. Weber at column 6, lines 28-39, describes the embodiment of Figure 1 as including multiple “label-like individual elements 17” that are subdivided by perforations 16. In this way, a plurality of labels 17 can be individually removed from the carrier foil 1 and subsequently applied to the substrate 8. Thus, it should be initially noted that Weber does not disclose applying security elements 17 directly to substrate 8 prior to removal from the carrier foil 1 (see Weber column 7, lines 14-24).

Contrary to the suggestion in the subject Office Action, the perforations 16 disclosed in Weber are not used to separate the individual elements 17 from the carrier foil, but rather are used to separate the individual elements from other individual elements 17. Also, the subject Office Action suggests that the perforations 16 of Weber extend through the base film 3. However, it should be noted that just prior to the label-like element 17 being applied to the substrate, as shown in Figure 2, there are no remaining perforations in the base film 3. At the

point where the transfer film 17 is applied to substrate 8, it has already been removed from carrier 1 and thus perforations 16 are no longer part of the structure.

Additionally, it should be noted with regard to Figure 1 of Weber that the outer sections of the transfer film 17 to the left and right side of the two perforations 16 are not merely excess laminate foil material that is somehow discarded after it is separated from base film 1. Rather, those other segments are additional individual label-like elements 17. Those labels 17 are separated from the base film 1 and subsequently used separately for security documents.

With regard to Garrard, it should be noted that there is clearly no teaching or suggestion to secure separate label-like elements into a booklet. In Garrard, the passbook 2 includes a single area 12, which comprises a coating of pressure sensitive UV material. The pressure sensitive UV material is intended to be transferred to an adjacent inside cover of the passbook 2. In this way, the area 12 acts like carbon paper, in order to transfer an account holder's signature onto an opposed sheet (in this case the inside cover). There is absolutely no reason to include perforations in the coating of area 12. Even assuming, for argument's sake, that the area 12 of Garrard could be replaced with the transfer film as taught by Weber (a contention Applicants still maintain is not taught or suggested in the art), one would not replace area 12 with multiple label-like elements 17. Similarly, it would be useless to include multiple Weber labels, including perforations, when such labels could only be transferred together to an adjacent page. The heat required to detach the decorative layer arrangement of Weber could not be isolated to apply to a single label-like element 17 and thus any separate adjacent label-like elements 17 separated by a

perforation would be transferred together. Once applied to the sheet, the perforations between the label-like elements 17 are rendered useless.

Thus, not only would one of ordinary skill not be motivated to combine Weber and Garrard, even if they were somehow combined, the invention defined in Claim 10 would not be rendered obvious. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections of the claims, and in particular Claim 10.

Applicants have intentionally refrained from introducing substantial amendments in this response in order to preserve their right to further appeal the patentability of the pending independent claims. Notwithstanding the above, if the Examiner determines after reconsideration that independent Claims 1 and 21 are not patentable and that Claim 10 includes allowable subject matter, then Applicants hereby authorize the Examiner to amend Claims 1 and 21 to incorporate the limitations of Claim 10, by Examiner's Amendment, in order to expedite a Notice of Allowance and issuance of a patent in the subject application.

**Conclusion**

If the Examiner has any questions or suggestions to further expedite allowance of this application, he is cordially invited to contact Applicants' attorney at the telephone number provided.

Respectfully submitted,

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